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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,278	03/04/2004	Dae-sik Kim	Q80119	4215

7590 12/29/2005

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EXAMINER
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CONSILVIO, MARK J

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/792,278

Applicant(s)

KIM ET AL.

Examiner

Mark Consilvio

Art Unit

2872

*(Handwritten signature)*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 9/26/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/7/2005</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 3-11 are currently pending. Claims 1 and 2 were previously withdrawn. Claims 3-11 were previously rejected and claims 7 and 11 are newly amended.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 7/7/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

The drawings were received on 9/26/2005. These drawings are acceptable.

### ***Response to Arguments***

Applicant's arguments with respect to claims 3-11 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al. (US Patent Application Publication No. 2004/0246589).

The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claim 3, Kim discloses an optical combining device for combining the paths of at least two light beams, comprising: a scroll direction change prism (140), disposed in the path of a first light beam which changes a scroll direction of the first light beam so as to be the same as that of a second light beam; and a beam shifter (150), disposed in the path of the second light beam, which shifts the second light beam so as to be combined with the first light beam incident from said scroll direction change prism (fig. 10).

With respect to claim 4, Kim discloses the scroll direction change prism (140) comprises: a first reflection surface which receives and reflects the first light beam; a second reflection surface which is disposed at a right angle to the first reflection surface and which reflects the first light beam incident from said first reflection surface; a third reflection surface which reflects the light beam incident from said second reflection surface in a direction parallel to that of the second light beam incident from said beam shifter (fig. 11).

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With respect to claims 5 and 8, Kim discloses said beam shifter (150) comprises an incident surface arranged inclined with respect to an optical axis of the incident second light beam and an exit surface arranged separated a predetermined distance from and parallel to the incident surface, wherein said beam shifter shifts the second incident light beam through refraction due to the refractive index of said beam shifter (fig. 10).

With respect to claim 6, Kim discloses said beam shifter (150) comprises first and second reflection surfaces arranged inclined with respect to an optical axis of the incident light beam, wherein said beam shifter shifts the second incident light beam through total internal reflection (fig. 10).

With respect to claim 7, Kim discloses An optical combining device for combining a first and a second beam, comprising: an Amici prism (140), disposed in the path of the first beam, which reverses a scrolling direction of the first beam; and a beam shifter (150), disposed in the path of the second beam, which shifts the path of the second beam toward the path of the first beam (figs. 10 and 11).

With respect to claim 9, Kim discloses said beam shifter (150) is a reflective element that shifts the path of the second beam by total internal reflection (fig. 10).

With respect to claim 10, Kim discloses a relay lens (161), disposed in the path of both the first and second beams, which refracts and converges the first and second beams (fig. 10).

With respect to claim 11, Kim discloses an optical combining device for combining a first and a second beam having different polarization directions, comprising: an Amici prism (140), disposed in the path of the first beam, which reverses a scrolling direction of the first beam; and a polarization beam splitter (163), disposed in the path of both the first beam, reflected from said

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Amici prism, and the second beam, which combines the first and second beams by selectively transmitting or reflecting the first and second beams according to the polarization direction thereof (figs. 10 and 11).

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17, 32, 33, and 34-37 of Application No. 10/764,488. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations of the instant application are claimed in the identified co-pending applications. Further, though the references also claim additional limitations, this does not distinguish over the instant claims which include open-ended language.

Specifically, claims 33-37 of Application No. 10/764,488 claims or reasonable suggests all the limitations of claims 3 and 10, 4 and 7, 5 and 8, 6 and 9, and 11, respectively, of the instant application or combinations thereof.

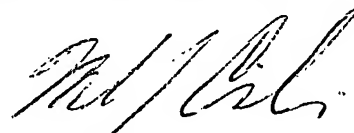
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

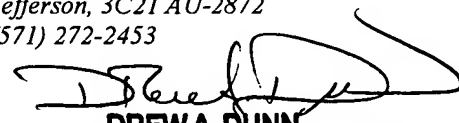
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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